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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,044	07/14/2003	John M. Meyer JR.	7779	6067
22922 7590 01/11/2007 REINHART BOERNER VAN DEUREN S.C. ATTN: LINDA KASULKE, DOCKET COORDINATOR 1000 NORTH WATER STREET SUITE 2100 MILWAUKEE, WI 53202			EXAMINER SAYALA, CHHAYA D	
			ART UNIT 1761	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			01/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/619,044

Applicant(s)

MEYER ET AL.

Examiner

C. SAYALA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102/ Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 32, 34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated or, in the alternative, under 35 U.S.C. 103(a) as obvious over Coody (US Patent 5007194), Yearley (US Patent 2102052) and Carr (US Patent 4463018).

All the above references teach artificial baits that are made from hides or rind that can be used as bait. The claims recite "crustacean bait" and such terminology is considered "use" terminology. The rejection is being made under both statutes due to applicant's amendment to the independent claims. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product

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was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted)

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

Claim Rejections - 35 USC § 103

2. Claims 1-29, 31-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams Jr. (US Patent 3964203) and Carr (US Patent 4463018) in view of Pfleiderer et al. (US Patent 4484924) Hague et al. (US Patent 6827041) and Talty et al. (US Patent 3408918) and further in view of Thiele (US Patent 4224028).

Using rinds/skins as fishing lures were known in the art at the time the invention was made. See for instance Williams, Jr, who teaches the use of pork rind in prior art and chamois in the reference invention, the latter being treated with cod-fish oil. The chamois is cut into strips and the strips have an attachment hole at one end for a fish hook. See claims. Carr also describes using hide as artificial bait incorporated with an attractant such as fish-oil. The patents do not teach the other steps of treating with alkali, washing, deliming etc.

Pfleiderer et al. teach washing for the removal of dirt, soaking in hydrated lime or alkalies to a pH of from 7-11, deliming with acids such as citric acid and finally, curing with NaCl. See col. 6, e.g. 1; col. 5, lines 16; col. 2, line 40, which teaches that mixing/washing can be done in a drum or in a mixer. Note too that in the soak liquor containing alkali that brings the pH value to between 8 and 10 (see line 63), "wetting agents" (detergents) are used. Thus all the steps were known in the art at the time the invention was made. To substantiate this fact, see Hague et al. who teach that skin is washed with alkali, washed with salts such as ammonium chloride, and then bleached. See col. 5, lines 3-10, which show the fat and oil is removed by agitating with sodium salts. The degrease materials can also be a detergent, and the skin is bleached so that the skin is low in oil and soft. See example 1. Talty et al., also drawn to processing of hides, show liming for a period of less than 4 days for periods of 3-12 hours or less, which reads on the limitation claimed instantly. The hide pieces are then neutralized with acids such as citric acid (see col. 3). The delimed, washed hides are then further processed to final products.

These references add to the disclosure of Pfeiderer et al. that processing steps from skin or hide to remove fat, flesh, hair and to bleach the skin or hide so as to form the final product were similar. Note that although only a few of the limitations pertaining to amounts, and time and temperature of wash/rinse water are disclosed as claimed, such determinations would depend primarily on the type and volume/weight of skin and hide, and end product used. To make minor modifications to known process steps shown by the references of Pfeiderer et al., Hague et al. and Talty et al. so as to prepare an artificial lure, to incorporate an attractant into the lure such as fish oil, a known fish attractant, would have been obvious to the practitioner at the time the invention was made. To add steps such as checking pH of the acid solution, draining washing solutions, adding more water or alkali or acid if more is necessary or to adjust such levels to below a particular required value, are steps that would have been routine and obvious to the skilled worker, barring any evidence to the contrary. To use temperatures of rinse liquids above 100° C also would also have been obvious for the logical scientific fact of removing fat and grease with warm water and adding to the degrease effect that one of ordinary skill would have associated with the degrease techniques used above with respect to the chemicals disclosed.

As for packaging the artificial lures, this limitation has been in use in prior art as shown by Carr (see col. 6). To choose plastic containers and to pack the attractant also with the bait would have been an obvious modification over applying the oil to the rawhide and then packing it. Disclosure of fish oil renders obvious all the specific oils claimed.

Artificial lures use rawhides, hides or skins, as shown by prior art and the process steps of liming, deliming, rinsing, bleaching, curing etc. such hides or skins are also known in the art, and the motivation to use such processes to prepare such artificial bait is to primarily clean them and to convert them to be stable, to prevent and/or retard putrefaction of skins, hides of freshly slaughtered animals. See Thiele. See col. 2, in Thiele, and though this patent is drawn to the tanning industry, the artisan would have recognized that in preparation of rawhide for a bait, the same problems exist because decay, putrefaction would have been inherent disadvantages to both utilities.

3. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pfleiderer et al. in view of Gould (US Patent 3670534) and Holdsworth (US Patent 3913360).

Although Pfleiderer et al. teach a mixer, they do not disclose any particular device. Mixing devices with respect to processing hides are disclosed by Holdsworth and Gould. To adjust the blades in a manner that would provide the necessary mixing, given the prior art devices and their blades would have been within the ambit of ordinary skill.

Response to Arguments

Applicant's arguments filed 10/18/2006 have been fully considered but they are not persuasive.

Burreson et al. (US Patent 4882174) @ col. 3, lines 20-25 and Orth, Jr. (US Patent 4206236) in the abstract, are both made of record to establish that the use of the same bait for crustaceans and fish was known in the art to one of ordinary skill in the art at the time this invention was made, vigorously traversing applicant's position that the claims be allowed on the basis that they are drawn to crustacean bait and the references to fish bait. These references show that unobviousness based on this fact cannot be persuasive.

At page 8 of his remarks, applicant states that claims 32, 34 and 36 are not anticipated because the references teach fish bait, not crustacean bait. In response, for composition claims, intended use of an otherwise old or obvious composition cannot render a claim patentable. In re Zierden, 162 USPQ 102, In re Jones, 50 USPQ 48, In re Spada, 15 USPQ 2d, 1655, In re Thuau 57 USPQ 324.

Further, applicant dismisses the rejection because the claims, in a process-by-product format, have been rejected under "old case law". He states that under "more recent case law", "The issue in these cases is typically whether the product is novel, that is, not in the prior art and is best described by the process by which it is made,

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or whether the process limitations merely narrow the scope of the previously-known product."

Then applicant decides that the bait and the steps used to make the bait is not taught or suggested by prior art and therefore the claims are allowable.

The rejection has been expanded to explain the Office position, whether the case law be old or new, and the rejection is being maintained.

At page 10, applicant has criticized the Williams reference because it uses bloodmeal as an attractant. The rejection is under 35 USC 103, and clearly, relies on Williams only for its prior art disclosure showing the use of skins/rind as fishing lures. Also, Williams teaches cutting rinds/skin into strips and shows treating it with fish oil, and an attachment hook. This is pertinent because, if hide can be cut into strips, they certainly can be cut to size. Cutting to size to suit a crustacean, cannot be said to be unobvious.

Carr teaches fabric or cheesecloth, applicant holds, not hide. Applicant has unduly limited his view of all that each reference would have fairly suggested to a person having ordinary skill in this art. Under 35 USC 103, a reference must be considered not only for what it expressly teaches, but also for what it fairly suggests. In re Burckel, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979). At col. 3, lines 5-8, Carr teaches fabric as a functional equivalent to hide. In the example, however, Carr discloses cheesecloth, as the fabric material. Applicant has failed to consider the disclosure at col. 3. It is well established that all of the disclosure must be considered

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not just the specific examples, In re Uhlig, 153 USPQ 460, In re Mills, 176 USPQ 196 (CCPA 1972).

Since the remaining remarks have been made on the premise that Carr teaches only cheesecloth as his bait, and this is erroneous at best, then the remaining remarks do not establish patentability either.

At page 11, applicant argues that the temperatures are in Fahrenheit, as described in the specification. While this may be true, the claims do not recite any units. Applicant cannot rely on the specification to impart to the claims limitations not recited therein. Such a reliance is ineffective to define over the prior art. In re Lundberg, 244 F2d 543, 113 USPQ 530 (CCPA 1957), In re Winkhaus, 188 USPQ 129 (CCPA 1975)

Applicant has stated that no prior art has been cited for amounts of alkali material, amounts of acidic material, amount of salt, and hydrogen peroxide. Applicant is urged to review the rejection again. All these limitations have been addressed. When prior art teaches all the general conditions even as far back as 1968 (Talty et al.) and 1984 (Pfleiderer et al.), then to determine amounts for the very same reagents used to treat the hide/skin, would have been obvious to the skilled worker. When cleaning materials/detergents are well known in the art, it does not come with the instruction regarding how much to use.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

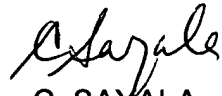
Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. SAYALA whose telephone number is 571-272-1405.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'C. Sayala', is positioned above the printed name.

C. SAYALA
Primary Examiner
Group 1700.